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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,442	02/13/2004	Ho-Keung Lee	Lee 2 (LCNT/126171)	8970
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WALL & TONG, LLP/ ALCATEL-LUCENT USA INC. 25 James Way Eatontown, NJ 07724			EXAMINER  PASIA, REDENTOR M	
			ART UNIT	PAPER NUMBER
			2474	
			MAIL DATE	DELIVERY MODE
			11/23/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/779,442

**Applicant(s)**

LEE, HO-KEUNG

**Examiner**

RENTOR PASIA

**Art Unit**

2474

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-6,13 and 16-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-6,13,16,24-30 and 32 is/are allowed.
- 6) ☒ Claim(s) 17-23 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment filed on 09/16/2010 has been entered. Claims 17-21, 23, 25-28 and 32 have been amended. Claim 14 has been canceled. No claims have been added. Claims 1, 3-6, 13 and 16-32 are still pending in this application, with claims 1, 13, 17 and 25 being independent.

- Rejections under 35 USC 112, 2<sup>nd</sup> Paragraph

Applicant's arguments, see Applicant's Remarks, filed 09/16/2010, with respect to claims 17-23, 25-28 and 31-32 have been fully considered and are persuasive. The rejection of claims 17-23, 25-28 and 31-32 has been withdrawn.

- Rejections under 35 USC 101

Applicant's arguments, see Applicant's Remarks, filed 09/16/2010, with respect to claims 25-28 and 32 have been fully considered and are persuasive. The rejection of claims 25-28 and 32 has been withdrawn.

### ***Response to Arguments***

Applicant's arguments with respect to claims 17-23 and 31 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 17-23 and 31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. **Claim 17** recites the limitation "a plurality of network elements" in line 6. It is not clear if the limitation "a plurality of network elements" in line 6 is related the limitation "a plurality of network elements" in line 1. If they are related, the limitation "a plurality of network elements" in line 6 must be revised to "[a] the plurality of network elements". If they are not related, Applicant is required to amend the claim in order to differentiate the limitations from each other. There is insufficient antecedent basis for this limitation in the claim.
4. **Dependent claims 18-23 and 31** contain a similar issue as discussed for claim 17 above, thus, the dependent claims are rejected for the same reasons as set forth above for claim 17.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claim 17-23 and 31** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. **Regarding independent claim 17**, although the preamble of the claim is directed to an apparatus and includes no tangible structural elements under the broadest reasonable interpretation, the apparatus covers the operating principle based on an algorithm with no limits on the claim scope. Thus, as no tangible structural embodiment is claimed, there is no evidence of a practical application. For claim 17, the claim would wholly embrace the software system of a network analysis module performing the algorithm detailed.

Thus, claim 17 is directed to non-statutory subject matter.

In the examination of the claims, since the apparatus covers the operating principle based on an algorithm (i.e. as performed by the network analysis module) with no limits on the claim scope, the Examiner has relied upon only on the "apparatus" for prosecution and not the claim limitation "network analysis module" and its related functions. See prior art rejections as indicated below.

8. **Dependent claims 18-23 and 31** contain a similar issue as discussed for claim 17 above, thus, the dependent claims are rejected for the same reasons as set forth above for claim 17.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(c) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. **Claims 17-23 and 31** rejected under 35 U.S.C. 102(e) as being anticipated by Nataranjan et. al. (US 7,293,106; hereinafter Nataranjan).

11. **As to claim 17**, Nataranjan shows an apparatus (Figure 3; network manager computer 314 performing the methods shown in Figures 1-2) for analyzing a plurality of network elements interconnected to form a communication network and configured to support at least one established communication path in the communication network , the apparatus comprising:

*\*\*\*In the examination of the claims, since the apparatus covers the operating principle based on an algorithm (i.e. as performed by the network analysis module) with no limits on the claim scope, the Examiner has relied upon only on the "apparatus" for prosecution and not the claim limitation "network analysis module" and its related functions.\*\*\**

a network analysis engine module adapted to perform,

responsive to receiving from one of a plurality of network elements included within an established communication path, a notification signal for querying a network element in the communication network for local network information, the local network information comprising one or more items selected from the group including topology information, connection information, and performance information, wherein the notification signal is indicative of the existence of the established communication path;

responsive to receipt of the local network information, an analysis of the local network information received to map an associated portion of the established communication path; and

responsive to the local network information received and the corresponding mapped portion of the established communication path, a selection of a next network element of the established communication path;

wherein the querying function is further responsive to a notification that the next network element has been selected.

12. **Dependent claims 18-23 and 31** contain a similar issue as discussed in claim 17 above, thus, the dependent claims are rejected for the same reasons as set forth above for claim 17.

*Allowable Subject Matter*

13. **Claims 1-6, 13, 16, 24-30 and 32** are allowed.

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REDENTOR PASIA whose telephone number is (571)272-9745.

The examiner can normally be reached on Mon-Thurs - 6:00AM-2:00PM EST and Fri - 6AM-4:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on 571-272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aung S. Moe/  
Supervisory Patent Examiner, Art Unit 2474

/REDENTOR PASIA/  
Examiner, Art Unit 2474



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